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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/698,902

10/30/2003

Shigemi Nakasato

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23392

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02/08/2006

FOLEY & LARDNER  
2029 CENTURY PARK EAST  
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EXAMINER

BALAOING, ARIEL A

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/698,902

Applicant(s)

NAKASATO ET AL.

Examiner

Ariel Balaoing

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 13, 14, 16, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by MOONEY et al (US 2002/0098878 A1).

Regarding claim 1, MOONEY discloses an electronic apparatus for communicating with first device and second device (abstract, Figure 1), comprising: a wireless communication device [headset] (20); means for establishing first wireless connection between said wireless communication device and the first device (Figure 1, abstract, paragraph 9-13), and second wireless connection between said wireless communication device and the second device (paragraph 9-13); and means for reproducing content data received through the first wireless connection (paragraph 21-22), wherein said establishing means establishes the second wireless connection while maintaining the first wireless connection in the case said wireless communication device receives a request to establish the second wireless connection from the second device while reproducing content data from the first device (paragraph 21-22, 31).

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MOONEY further discloses wherein the

establishing means establishes the first wireless connection under a first condition in which said wireless communication device functions as a master (paragraph 24).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MOONEY further discloses wherein the establishing means has means for setting the first wireless connection under a second condition other than the first condition (paragraph 24; headset can be master or slave).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MOONEY further discloses further comprising means for outputting notification indicating that said wireless communicating device received a request to transmit a voice call from the second device (paragraph 21, 27, 31).

Regarding claim 5, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MOONEY further discloses wherein said reproducing means includes a speaker which outputs a sound reproduced from the content data, and said outputting means makes said speaker output the notification with louder volume than that of the sound reproduced by said reproducing means (paragraph 21, 27, 31; notification of incoming call is overlaid music being played. Also, it is inherently necessary for the notification to be louder than reproduced sound as it would not be possible to hear if notification was of a lower decibel).

Regarding claim 6, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MOONEY further discloses wherein said establishing means is further operative for establishing a wireless connection with said

second device even though said second device has not requested a connection (paragraph 22).

Regarding claim 7, MOONEY discloses an electronic apparatus for communicating with first device and second device (abstract, Figure 1), comprising: a wireless communication device [headset] (20); means for establishing first wireless connection between said wireless communication device and the first device (Figure 1, abstract, paragraph 9-13), and second wireless connection between said wireless communication device and the second device (paragraph 9-13); and means for reproducing content data received through the first wireless connection (paragraph 21-22); means for outputting a notification indicating that said wireless communicating device received a request for a voice call from the second device through the second wireless connection (paragraph 21, 27, 31); means for inputting an instruction to receive the voice call (paragraph 21, 27, 31); means for adjusting a sound reproduced by said reproducing means in relation to the operation of said inputting means (paragraph 31); and means for communicating with the second device using voice data through the second wireless connection while the sound reproduced by said reproducing means is adjusted (paragraph 31).

Regarding claim 8, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MOONEY further discloses wherein said adjusting means has first sending means for sending to the first device a first request for stopping transmitting the content data (paragraph 31; music can be stopped if user does not want to hear it during a call).

Regarding claim 13, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MOONEY further discloses a headset for communicating with first device and second device (abstract), comprising: a wireless communication device (20); first establishing means for establishing first wireless connection between said wireless communication device and the first device (paragraph 9-13); means for reproducing content data received through said first wireless connection (paragraph 9-13, 31); second establishing means for establishing second wireless connection between said wireless communication device and the second device while the first wireless connection is maintained in the case said wireless communication device receives a request to establish the second wireless connection from the second device under a condition in which said reproducing means is reproducing the content data (paragraph 9-13, 21, 27, 31); means for outputting a notification indicating that said wireless communicating device received a request for a voice call from the second device through the second wireless connection (paragraph 21, 27, 31); means for inputting an instruction to receive the voice call (paragraph 21, 27, 31); means for communicating with the second device using voice data through the second wireless connection (paragraph 21, 27, 31); and means for adjusting a sound reproduced by said reproducing means while the communicating means is operating (paragraph 21, 27, 31).

Regarding claim 14, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. MOONEY further discloses wherein said adjusting means has means for sending to the first device a request for stopping transmitting the

content data (paragraph 31; music can be stopped if user does not want to hear it during a call).

Regarding claim 16, MOONEY discloses a connection control method for an electronic apparatus that communicates with a first device and a second device (abstract), comprising the steps of: establishing a first wireless connection between the electronic apparatus and the first device (paragraph 9-13); reproducing content data received through the first wireless connection (paragraph 9-13); and establishing a second wireless connection between the electronic apparatus and the second device while maintaining the first wireless connection in the case the electronic apparatus receives a request to establish the second wireless connection from the second device during the reproduction of the content data (paragraph 21, 27, 31).

Regarding claim 17, MOONEY discloses a connection control method for an electronic apparatus that communicates with a first device and a second device (abstract), comprising the steps of: establishing first wireless connection between the electronic apparatus and the first device; reproducing content data received through the first wireless connection (paragraph 9-13); establishing second wireless connection between said wireless communication device and the second device while the first wireless connection is maintained, corresponding to a request to establish the second wireless connection from the second device (paragraph 9-13, 21, 27, 31); outputting a notification indicating that the electronic apparatus received a request for a voice call from the second device through the second wireless connection (paragraph 21, 27, 31); inputting an instruction to receive the voice call (paragraph 21, 27, 31); adjusting a

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sound reproduced by said reproducing means (paragraph 21, 27, 31); and communicating with the second device using voice data through the second wireless connection under the condition the sound is adjusted (paragraph 21, 27, 31).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to



consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 9-12, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over MOONEY et al (US 2002/0098878 A1) in view of YI et al (US 6,407,325 B2).

Regarding claim 9, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although MOONEY resuming default audio when an event is finished (paragraph 27, 28), MOONEY does not expressly disclose wherein said adjusting means has second sending means for sending to the first device a second request for restarting transmitting the content data. YI discloses wherein an adjusting means has a sending means for sending to a first device a second request for restarting transmitting the content data (303, 303a, 303b, 307a). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MOONEY to include the pause and muting of audio content, as disclosed by YI, as both inventions are related to the handling of an audio source when an incoming call arrives. This is beneficial in that the ability to hear the caller is greatly increased if audio being listened to is reduced.

Regarding claim 10, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. Although MOONEY teaches restarting the transmission of content data, MOONEY does not expressly disclose wherein said second sending means requests a content data following the content data which has already been transmitted. YI discloses a sending means requests a content data following the content data which has already been transmitted (303, 303a, 303b, 307a).

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Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MOONEY to include the pause and muting of audio content, as disclosed by YI, as both inventions are related to the handling of an audio source when an incoming call arrives. This is beneficial in that the ability to hear the caller is greatly increased if audio being listened to is reduced.

Regarding claim 11, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, MOONEY does not disclose wherein said adjusting means has means for muting the sound reproduced by said reproducing means. YI discloses wherein said adjusting means has means for muting the sound reproduced by said reproducing means (305). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify MOONEY to include the pause and muting of audio content, as disclosed by YI, as both inventions are related to the handling of an audio source when an incoming call arrives. This is beneficial in that the ability to hear the caller is greatly increased if audio being listened to is reduced.

Regarding claim 12, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, MOONEY does not disclose wherein said adjusting means has means for recovering the sound after the communication through the second wireless connection has finished. YI discloses wherein said adjusting means has means for recovering the sound after the communication through the second wireless connection has finished (307).

Regarding claim 15, see the rejections of the parent claim concerning the subject matter this claim is dependent upon. However, MOONEY does not disclose wherein said adjusting means has means for muting the sound reproduced by said reproducing means. YI discloses wherein an adjusting means has means for muting a sound reproduced by a reproducing means (305).

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WINGATE (US 6,006,115) – Wireless headphones for entertainment and telephonic communication

BATES et al (US 6,628,964 B1) – Combination cordless telephone and remote control for entertainment equipment

ANVEKAR et al (US 2002/0068610 A1) – Selecting source device and content delivery via wireless connection

KITAMURA (US 5,987,106) – Automatic volume control system

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing  
Art Unit 2683  
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AB



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